REMARKS

This responds to the Office Action mailed on August 12, 2004.

Claims 1, 9, and 17 are amended; as a result, claims 1-20 are now pending in this application.

Applicant acknowledges and appreciates the phone interview conducted between Applicant's representative and the Examiner on November 10, 2004. During the conference no references were discussed; rather the present 101 and 112 rejections were discussed.

During that interview the Examiner indicated that if the preambles to the independent claims were amended to indicate that the methods were directed to "processing footnotes implemented in a computer-readable medium" then this would be sufficient to overcome these rejections. Applicant has made these amendments as listed above in the manner requested by the Examiner.

Moreover, these amendments are the only ones being made with this Amendment and Response and are being made for purposes of correcting informalities in the claims as perceived by the Examiner. Therefore, Applicant believes that entry of these amendments is proper and respectfully request an indication of the same from the Examiner.

§112 Rejection of the Claims

Claims 1-8 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The preamble to independent claim 1 now recites a "method of processing footnotes implemented in a computer-readable medium." This is in compliance with the Examiner's instructions during a phone interview conducted on November 10, 2004. Therefore, Applicant believes that these rejections are no longer appropriate and should be withdrawn.

Claims 17-20 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The preamble to independent claim 17 now recites a "method of

processing footnotes implemented in a computer-readable medium." This is in compliance with the Examiner's instructions during a phone interview conducted on November 10, 2004. Therefore, Applicant believes that these rejections are no longer appropriate and should be withdrawn.

§101 Rejection of the Claims

Claims 1-20 were rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. The preamble to independent claims 1, 9, and 17 now recite methods "of processing footnotes implemented in a computer-readable medium." This is in compliance with the Examiner's instructions during a phone interview conducted on November 10, 2004. Therefore, Applicant believes that these rejections are no longer appropriate and should be withdrawn.

§102 Rejection of the Claims

Claims 1-6 and 9-16 were rejected under 35 USC § 102(b) as being unpatentable over Chirokas et al. (U.S. Patent No. 5,111,397). It is of course fundamental that in order to sustain an anticipation rejection that each and every step in the rejected claims must be taught or suggested in the cited reference.

Webster defines the verb invert as "to reverse in position, order, or relationship." *See*, Merriam-Webster On-Line Dictionary at http://www.m-w.com/, keyword "invert." Conversely, Webster's defines the verb revert as "to come or go back." *See*, Merriam-Webster On-Line Dictionary at http://www.m-w.com/, keyword "revert."

The distinction between inversion and reversion is a significant one, and one in which the Examiner has missed as evidenced by the Examiner's attempt to use these different terms in a synonymous manner. Inversion is the reversal of positions whereas reversion means to come or go back from where one came. Applicant asserts that the Examiner cannot use terms in manners that are inconsistent with how these terms are commonly understood on their face within the English language and in manners that are inconsistent with how they are understood in the

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programming arts. The term "reversion" cannot be read so broadly that it conflicts with its ordinary and commonly understood meaning.

Reversion in the Chirokas is consistent with its ordinary meaning and is used to mean to pause or stop one step of processing and to go back to a previous processing step. Chirokas does not teach or even remotely suggest "inversion." The support that the Examiner recites to establishes "reversion/inversion (*sic*)" states "the 'last good line' structure is updated including the necessary line ending variables . . . the program then *returns* to block 201 of FIG. 6 and the process of assembling the next line of body text is started." *Emphasis Added.*

To demonstrate why this does not teach inversion as the Examiner has suggested. Applicant would like to discuss Chirokas in more detail and its methods. First, Chirokas passes on the data twice, as was explained to the examiner in detail in the prior Response to the First Office Action. This is exemplified in the discussion of FIG. 2 of Chirokas, where it is stated "the remaining lines of the page *are all needed* for footnotes." *Emphasis Added.* The Examiner's attention is also directed to the discussion of FIG. 6 where it is stated the "footnote references and other relevant information about the referenced footnotes *are saved for later use.*" *Emphasis Added.*

Chirokas counts lines of text; it saves and stores information during a first pass which then permits it to format or output documents with footnotes in multiple configurable manners based on the saved and previously processed information. Again, as was explained in the prior Response to the First Office Action, Chirokas uses traditional computations and multiple passes on the data in order to render footnotes. In fact, Chirokas acknowledges this and states that the reason it is unique is because it "believe[s] that no other prior art program will provide two (or more) . . . messages on the same output page." In other words, Chirokas believes that it is unique because it can format footnotes in multiple manners because of its unique way of storing and processing data previously processed and retained during an initial first pass on the data.

Now returning to the statement regarding updating the last good line and returning to block 201, it is noted that at column 6 lines 27-29 that Chirokas states that some processing is conventional and not unique to Chirokas. Chirokas goes on to explain that the program recalls a last good line, and a last good line is defined as a previous or last line of body text that did not

violate any rules of style. Chirokas, col. 6, lines 33-35. The program then returns or reverts back to processing depicted at 201. There is not a single indication anywhere in Chirokas that inversion is used. In fact, quite the contrary Chirokas employs multiple passes and calculations against body text and footnotes at various times and reverts processing back to previous processing points or routines. Therefore, Applicant respectfully disagrees with the Examiner's conclusions and again asserts that there is no inversion in Chirokas; even if Chirokas has reversion. Moreover, it is clear that inversion is not synonymous with reversion as the Examiner has asserted and as was clearly demonstrated above.

Applicant's independent claims 1 and 9 positively recite inversion. Specifically, claim 1 state "inverting the non footnote body data to one or more second locations" and claim 9 states "inverting a start location and an end location." These limitations are not taught or even remotely suggested in Chirokas. If Chirokas had taught inversion then nearly all of its processing techniques would be unnecessary and it could have been substantially simplified.

Accordingly, Applicant respectfully assets that the rejections with respect to Chirokas should be withdrawn because Applicant believes that the Examiner has fundamentally misinterpreted the teachings of Chirokas and has improperly used two terms synonymously with one another (invert and revert) in an effort to improperly expand the fundamental teachings of Chirokas and in direct contradiction with how these terms are well-understood in both the English language and in the programming arts.

Claims 17-20 were rejected under 35 USC § 102(b) as being unpatentable over Cuan et al. (U.S. Patent No. 4,503,515). Again, it is fundamental that in order to sustain an anticipation rejection that each and every step in the rejected claims must be taught or suggested in the cited reference.

Webster defines the verb "assemble" as "to bring together." *See*, Merriam-Webster On-Line Dictionary at http://www.m-w.com/, keyword "assemble." Contrast that with the verb "invert" which means to "to reverse in position, order, or relationship." *See*, Merriam-Webster On-Line Dictionary at http://www.m-w.com/, keyword "invert." Thus, although all footnote processing methods may do assembling this does not mean that any of them (except Applicant's

invention) does inversion. Again, the terms "assemble" and "invert" are not synonymous terms. It appears once again to the Applicant that the Examiner is improperly interpreting terms in violation of each term's well-known and established meaning and in violation with how each term is understood in the programming arts for purposes of concluding Applicant's invention anticipated. Applicant respectfully asserts that this is improper and not supported by the law of claim interpretation.

Although, it may appear now after reading Applicant's disclosure that inversion is a straightforward solution to the problem of footnote processing; this conclusion cannot be used against the Applicant unless the Examiner can supply a single reference or a combination of references where inversion is used for footnote processing. Without such references, the Examiner's conclusions are improper hindsight established only after reading and comprehending Applicant's invention. It is also well-established that improper hindsight cannot be used to reject an Applicant's claims.

One of ordinary skill in the art would not and could not have read Cuan for purposes of teaching the inversion of footnotes. The references cited within the Cuan patent at best describe assembling footnotes either at the end of a page or at the end of a whole document. All footnote processing techniques do this; this is not what is unique or novel about Cuan.

Cuan clearly takes an approach that is similar to Chirokas in that in Cuan, once again, footnotes and body text are separated and separately stored and then processed with a variety of editing options for purposes of reassembling the footnotes and body text. *E.g.,* Cuan, Abstract. Cuan can only assemble after it has the body text and footnotes separately stored; at this point, Cuan then introduces novel editing features and merging or assembling features. However, Cuan does not invert the footnotes and the body text within a unit of media which is clearly and positively recited in Applicant's independent claim 17.

Therefore, Applicant respectfully asserts that the present references cannot be used to anticipate Applicant's independent claims. Furthermore, Applicant respectfully requests that the rejections be withdrawn and the claims allowed.

§103 Rejection of the Claims

Claims 7-8 were rejected under 35 USC § 103(a) as being unpatentable over Chirokas et al. (U.S. Patent No. 5,111,397) in view of Ferrel et al. (U.S. Patent No. 5,860,073). Claims 7 and 8 are dependent from independent claim 1. Therefore, for the reasons stated above with respect to claim 1 these rejections should be withdrawn and claims 7-8 allowed. Applicant respectfully requests an indication of the same.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 11-12-04   By _____
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this _12th_ day of November, 2004.

PATRICIA A. HULTMAN

Name   Signature